

## **REMARKS**

Claims 6-18 were pending in the application. Claims 6 and 11 have been amended. No new matter has been introduced. Support for the amendments can be found in Applicant's specification as published in United States Patent Publication 2002/0165901, specifically at paragraphs [0022], [0044], and [0046]. Applicant respectfully requests reconsideration.

## **CLAIM REJECTIONS UNDER 35 USC §101**

The Office Action rejected claims 6-10 under 35 USC 101 as being directed to non-statutory subject matter. The Examiner's argument centers on the test for being statutory by producing "a useful, concrete and tangible result" as indicated in *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). In the case of *In re Bilski*, Case 2007-1130, page 20, (Fed. Cir, Oct 30, 2008), the Federal Circuit held that the arguments of *State Street* will no longer be considered dispositive of the issue of subject matter patentability. However, the final Office Action maintains the rejection under 35 U.S.C. §101 on the basis that the claimed invention allegedly has no practical application. This is interpreted as being the same basis as that which the Federal Circuit said in *Bilski* is not a proper test for subject matter patentability.

The final Office Action appears to justify the use of a now discredited test by saying that "the portions of the opinions in *State Street* and *AT&T* relaying solely on a 'useful, concrete and tangible' result analysis should no longer be relied on." [emphasis in Office Action but not in the *Bilski* opinion]. See Final Office Action at page 3. However, the Office

Action cites no support for rejecting the claims other than ‘useful, concrete and tangible’ result analysis and hence it relies *solely* on this test. Therefore the Office Action has not provided a *prima facie* case of patent ineligibility. The Board of Patent Appeals and Interferences recently said:

“Therefore we also conclude that the “useful, concrete and tangible result” inquiry is inadequate and reaffirm that the machine-or-transformation test outlines by the Supreme Court is the proper test to apply.” *In re Bo Li*, Appeal No. 2008-1213 (BPAI, November 6, 2008 ). In *Bo Li*, the Board held: “It has been the practice for a number of years that a “Beauregard Claim” of this nature be considered statutory at the USPTO as a product claim. (MPEP 2105.01, I).”

Independent claim 6 is tied to an article of manufacture and independent claim 11 is a method claim performed by a computer system. Specifically, claim 11 has been amended to require that a computer perform every step of the claim method. Support for this amendment is found at paragraph [0046] of United States Patent Publication 2002/0165901. The dependent claims are directed to the same patentable subject matter as their parent claims. Therefore, both meet the “machine” prong of the Machine or transformation test. *See Bo Li, supra.*

Even though Applicant believes that the rejection under section 101 used the wrong test, to advance prosecution, claims 6 and 11 have been amended to require that the characterization is to be used at runtime to recognize groups of objects efficiently, as the objects are created, in repeated runs of an object-oriented program. Support for this is found at paragraph [0022]. This provides the useful result that the computer runs faster. See paragraph [0003].

Serial Number 10/073,608  
Docket Number YOR920020050US1  
**Amendment after Final Page** 7 of 7

For the foregoing reasons, Applicant respectfully requests allowance of the pending claims. The undersigned authorizes the Director to charge any fees as appropriate, or credit any overpayments, to Deposit Account Number 50-0510.

Respectfully submitted,

/Michael J. Buchenhorner/

Michael J. Buchenhorner  
Reg. No. 33,162

Date: January 26, 2009

Michael Buchenhorner, P.A.  
8540 S.W. 83 Street  
Miami, Florida 33143  
(305) 273-8007 (voice)  
(305) 595-9579 (fax)